

# Notice of Allowability

Application No.

10/765,070

Examiner

Sing P. Chan

Applicant(s)

OSHIMA ET AL.

Art Unit

1734

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to \_\_\_\_\_.
2. ☒ The allowed claim(s) is/are 1 and 3.
3. ☒ The drawings filed on 28 January 2004 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 1/28/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 3, drawn to a method for image formation, classified in class 156, subclass 235.
  - II. Claims 4 and 5, drawn to an intermediate transfer recording medium, classified in class 428, subclass 29.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as a protective covering for documents.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for Group II, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Jacob Doughty on May 4, 2005 a provisional election was made with traverse to prosecute the invention of group I, claims

Art Unit: 1734

1 and 3. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4 and 5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### **EXAMINER'S AMENDMENT**

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jacob Doughty on June 13, 2005.

The application has been amended as follows:

1. A method for image formation, comprising ~~the steps of:~~  
providing an intermediate transfer recoding medium comprising a substrate film and a transfer portion provided separably on the substrate film, the transfer portion comprising a receptive layer and a hologram layer and being divisible into a plurality of first and second image plane portions alternation across the transfer portion, each first image plane portion including a hologram image;

forming an print image on the intermediate transfer recording medium in at least one of the first image plane its transfer portions, wherein, in the intermediate transfer recording medium, a hologram image is set every at least second image plane and an image is formed on the transfer portion with the hologram image formed thereon so that the at least one of the first image plane portions includes the print image and at least one of the hologram images;

transferring the transfer at least one first image plane portion onto an object; and, thereafter, again subsequently transferring at least one of the second image plane portions the intermediate transfer recording medium in its next transfer portion once or more onto the at least one first image plane portion the object with the image formed thereon.

3. A method for image formation, comprising the steps of:

providing an intermediate transfer recording medium with a hologram, wherein a transfer portion comprising a transfer portion, the transfer portion comprising a receptive layer and a hologram layer and being divisible into a plurality of first and second image plane portions is provided which has at least two different hologram images alternately provided in the image plane portions as counted on the assumption that one image is set in one image plane alternating across the transfer portion, each first image plane portion including a first hologram image and each second image plane portion including a second hologram image;

forming an print image on the transfer portion at least one first image plane portion in its region having one type of hologram image;

transferring ~~the transfer~~ the at least one first image plane portion with the formed print image onto an object; and

~~, thereafter, again~~ subsequently transferring the at least one of the second image plane portions ~~intermediate transfer recording medium, with a hologram, it its next transfer portion once or more, onto the object~~ first image plane portion with the image formed thereon.

Claims 4 and 5 have been cancelled.

***Allowable Subject Matter***

7. Claims 1 and 3 are allowed.

8. The following is an examiner's statement of reasons for allowance: The claims recite a method of forming an image. The method includes providing an intermediate transfer recording medium comprising a substrate film and a transfer portion provided separably on the substrate film, transfer portion comprising a receptive layer and a hologram layer and being divisible into a plurality of first and second image plane portions alternating across the transfer portion with each first image plane portion including a hologram image (claim 1), and each of the second image plane portion including a second hologram image (claim 2), forming a print image on the first image plane portion such that the first image plane portion includes the print image and a hologram image, transferring the first image plane portion onto an object, and subsequently transferring at least one of the second image plane portions onto the first image portion (claims 1 and 2). Onishi et al (U.S. 6,290,798) discloses a method of

Art Unit: 1734

forming a printed product. The method includes providing a intermediate transfer recording medium comprising a base film, a transfer layer separably from base film, the transfer layer comprising a receptor layer, release layer, and a hologram layer, forming a print image onto the receptor layer, applying an adhesive sheet to either the transfer layer or a transfer receiving layer, i.e. object, and transfer the transfer layer onto the object. (Col 9, lines 28-67) Onishi et al does not disclose transfer portion being divisible into a plurality of first and second image plane portions alternating across the transfer portion with each first image plane portion including a hologram image (claim 1), and each of the second image plane portion including a second hologram image (claim 2), forming a print image on the first image plane portion such that the first image plane portion includes the print image and a hologram image, transferring the first image plane portion onto an object, and subsequently transferring at least one of the second image plane portions onto the first image portion (claims 1 and 2). Yukio (JP 11-272153) discloses a method of forming a multi-layered hologram. The method includes providing a plurality of hologram photosensitive material layers 1(R), 1(G), and 1(B) on a temporary base material, recording different characteristics, transferring sequentially, and stacking the holograms material layers onto a final substrate. (See English abstract of JP 11-272153) Yukio does not discloses transfer portion comprising a receptive layer and a hologram layer and being divisible into a plurality of first and second image plane portions alternating across the transfer portion with each first image plane portion including a hologram image (claim 1), and each of the second image plane portion including a second hologram image (claim 2), forming a print image

Art Unit: 1734

on the first image plane portion such that the first image plane portion includes the print image and a hologram image, transferring the first image plane portion onto an object, and subsequently transferring at least one of the second image plane portions onto the first image portion (claims 1 and 2). A search of the prior art of record did not disclose reference or references with the recited features.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Friday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Chan Sing Po*  
spc

*CA Fiorilla*  
**CHRIS FIORILLA**  
**SUPERVISORY PATENT EXAMINER**  
*AU 1734*